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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
037925.0005	

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Application Number	Filed
10630532	2003-07-30

First Named Inventor	
Morris, Daniel R.	
Art Unit	**Examiner**
3689	Long, Fonya M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 38076
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Thomas F. Bergert/
Signature

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Typed or printed name

434-951-5700
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2010-10-01
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REMARKS

Applicant submits that the Office Action issued on July 2, 2010 (the "Office Action") by the Examiner in the present application contains clear errors and omissions. While the action is non-final, the claims have been rejected twice and thus Applicant submits that this application is ripe for appeal and pre-appeal conference.

On pages 2 through 4 of the Office Action, the Examiner has analyzed Applicant's declaration under 37 CFR § 1.132 nearly entirely as if it were a declaration attributing the prior art to Applicant under MPEP § 716.10. Applicant has never made any such argument or declaration, explicitly or implicitly. Applicant's declaration pertains largely to the commercial success of the claimed invention, which has not been properly considered or addressed by the Examiner. While Applicant's response filed June 8, 2010 asserted copying by others, Applicant is not attributing the cited prior art to Applicant, but rather stating that other parties are copying Applicant's invention, as specified in the declaration and Exhibit F accompanying Applicant's response.

Applicant asserts that the Examiner has essentially ignored Applicant's arguments and declaration with regard to the commercial success of the invention. The Examiner's only mention of commercial success is as follows on page 4 of the Office Action:

> In the arguments on page 9 Applicant notes that these exhibits prove commercial success. However, there are no attached financial documents or sales and invoice information. How does the website training manual teach commercial success? These references fail to prove inventorship and the declaration is considered inadequate and insufficient to prove commercial success.

As stated above, Applicant has not submitted a declaration of inventorship or attribution with regard to the cited prior art. Thus, failing "to prove inventorship" is irrelevant. Further, page 9 of Applicant's response filed June 8, 2010 and paragraph 27 of the accompanying declaration outline how the training manual applies to commercial success, by showing a nexus between the commercial success and the claimed invention. See MPEP § 716.03 and cases cited therein. Thus, the Examiner's above question indicates that the Examiner does not appear to have considered Applicant's response or declaration. Further, Applicant has made a declaration under oath as to commercial sales. There is no requirement

Applicant is aware of to document, for example, nearly $6 million in sales in 2009 to prove what Applicant is declaring under oath.

As a result, there is only a conclusory statement left from the Examiner that "the declaration is considered inadequate and insufficient to prove commercial success." Applicant submits that this does not amount to an adequate evaluation of objective evidence of non-obviousness as mandated by *Graham v. John Deere Co.*, 148 USPQ 459 (1966), as noted in MPEP § 1504.03. MPEP § 1504.03 mandates that examiners evaluate evidence of commercial success submitted by patent applicants to determine whether there is objective evidence of success, and whether the success can be attributed to the claimed invention. Applicant submits that the Examiner has not done so in this application and thus there have been clear errors and omissions in the consideration of Applicant's response.

Applicant is entitled to have all evidence fully considered on the merits. See *In re Sullivan*, 84 USPQ2d 1034, 1038-39 (Fed. Cir. 2007) (citing *In re Soni*, 34 USPQ2d 1684 (Fed. Cir. 1995) (stating that "all evidence of nonobviousness must be considered when assessing patentability") and *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983) ("If, however, a patent applicant presents evidence relating to these secondary considerations, the board must always consider such evidence in connection with the determination of obviousness.")).

Applicant respectfully submits that the lack of consideration of Applicant's declaration is a clear error and/or omission. Reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of the claims is requested.

Respectfully submitted,

Date: 10/1/2010

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